

**UNITED STATES DEPARTMENT OF COMMERCE****United States Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Handwritten signature

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/321,633	05/28/99	KENNEY J	E-1901

IM22/0726

JOSEPH M KONIECZNY
86 THE COMMONS AT VALLEY FORGE EAST
1288 VALLEY FORGE ROAD
P O BOX 750
VALLEY FORGE PA 19482-0750

EXAMINER

BEX, P

ART UNIT	PAPER NUMBER
----------	--------------

1743

Handwritten number 5

DATE MAILED: 07/26/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.

09/321,633

Applicant(s)

KENNEY, JAMES W.

Examiner

P. K. Bex

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 May 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on 21 May 2001 is: a) ☒ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Drawings

1. The corrected or substitute drawings were received on 21 May 2001. These drawings are approved by the examiner.

Specification

2. The newly submitted abstract of the disclosure is objected to because should be limited a *single* paragraph. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-30 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1, 22 and 29 now include the limitation wherein the bracket has a socket with an open top and bottom and a slit extending lengthwise from the top of the socket to the bottom of the socket. Additionally, the slit having a width which smaller than the diameter of the socket and the pipette connector but larger than the diameter of a standard laboratory pipette. Such a "slit" limitation is not believed to be supported within the instant specification. The specification does disclose a pair of forks 42, 44 which extends horizontally from the base

member of the pipette holster. Wherein each fork has a circular socket 46, 48 formed in between the prongs of each fork. The diameter of the first socket DS1 and second socket DS2 are both larger than the distance DP between the prongs of the forks. There is no disclosure within the instant specification of a *slit width* which is smaller than the diameter of the socket, see paragraph bridging pages 11-12.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, paragraph b, lines 7-13, the newly introduced limitation "slit" is creates confusion and uncertainty as to how this slit diameter differs from the socket diameter. Same deficiency was found in claims 22 and 29.

Additionally, the diameter of the standard laboratory pipette is not definite. It is not clear what applicant considers a *standard* laboratory pipette since many different types of pipettes are used in the industry, i.e. manual, electric, etc.

Claim 35, paragraph a, lines 9-10, it is unclear as to how valve is "constructed and arranged" to selectively regulate the flow of air through the conduit. Same indefinite language is used to describe how the gun holster is mounted and the bracket socket.

Paragraph b, the term "generally" is not a positive recitation and renders the claim indefinite. Further, it is unclear as to what applicant means by the phrase "oriented generally, vertically downwardly". Same deficiency was found in claim 38.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 1-14, 22, 28-30 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kenney (USP 5,090,255) in view of Columbus (USP 4,437,586).

Kenney teaches a pipette gun 17 having a remote source of air pressure 55 with an external flexible air conduit, a housing with hand grip portion, a barrel portion, a pipette connector 23 oriented transverse to the barrel portion 21, an internal conduit 61, a valve 31 intermediate the internal conduit, a positive 27 and negative 25 air flow trigger connected to the valve, and a on/off switch 63 for regulating the flow of power to the remote air source (Fig. 1). Kenney teaches the switch such that the operator turns on the pipet apparatus when the dispensing procedure begins (claim 1). It is inherent within the reference that the power switch is turned off after the operator is done using the pipet apparatus. Additionally, this switch through the microprocessor 43 automatically activates/deactivates the air pressure source. Kenney fails to teach a gun holster arranged to support the gun above the worktable. Columbus teaches a pipette

holster use to support the pipette 10 above the work table in a vertical direction, comprising a base, a means for fastening the base to the vertical wall S, and mounting bracket 42 having a forks with prongs 46, 48 and circular sockets 50, 52 constructed to removably hold the pipette (Fig. 1). Wherein the socket comprise a slit which extends from the top of the socket portion to the bottom. This slit having a width which is smaller than the diameter of the socket (Fig. 1). Such use of a bracket insures that the pipette tube does not touch anything and will remain sterile.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included in the dispensing means of Kenney, the pipette holster, as taught by Columbus, in order to insure that the pipette tube does not touch anything and will remain sterile.

With respect to the shape of the external conduit, it would have been obvious to one of ordinary skill in the art to coil a portion of the external conduit of Kenney, in order prevent most of the conduit from touching the table and possibly knocking over lab equipment on the table.

With respect to the specific fastening means it would have been an obvious matter of design choice to use suction cups, Velcro tabs or magnets. Since applicant has not disclosed that these specific fastening means solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with the fixing means taught by Columbus.

9. Claims 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kenney (USP 5,090,255) in view of Columbus (USP 4,437,586), as applied to claim 1 above, and further in view of Nycum (USP 4,066,234).

Kenney and Columbus as discussed above, fail to teach a mounting pad for the air pressure source. Nycum teaches a universal mounting pad 11 with plurality of bores 28-29 for accepting structures 24-25 on equipment 10 and 30 (Figs. 1-2). Such a mounting pad is used for

protecting fragile equipment against shock and vibration (abstract). Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included in the dispensing means of Kenney and Columbus, the mounting pad, as taught by Nycum, in order to insure protection fragile pump equipment against shock and vibration.

10. Claims 31-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kenney (USP 5,090,255) in view of Nycum (USP 4,066,234).

Kenney as discussed above, fails to teach a mounting pad for the air pressure pump for a pipette gun. Nycum teaches a universal mounting pad 11 with plurality of bores 28-29 for accepting structures 24-25 on equipment 10 and 30 (Figs. 1-2). Such a mounting pad is used for protecting fragile equipment against shock and vibration (abstract). See reasons in previous rejection.

Allowable Subject Matter

11. Claims 35-42 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

12. The following is a statement of reasons for the indication of allowable subject matter: The prior art does not teach or suggest a pipette gun holster which includes a first switch which is located proximate to the holster socket and functions to deactivate the air source when the pipette gun is parked in the holster and to energize the air source when the pipette gun is removed from the holster.

Response to Arguments

13. Applicant's arguments filed May 21, 2001 have been fully considered but they are not persuasive. Applicant argues that Columbus (USP 4,437,586) does not teach a slit which is different than the diameter of the socket. Examiner points to Fig. 1 of Columbus which

disclose a "slit" which is smaller in length than that of the diameter of the socket. Applicant argues that Nycum (USP 4,066,234) does not teach a means on the bottom side of the base layer for fastening the vibration absorbent material to a horizontal or vertical surface.

Nycum does teach a resilient polyurethane foam base layer 11, notorious for providing shock absorption, which is securely fastened to a horizontal surface 12 (Fig. 1) via glue or some other type of adhesive, see column 2, lines 17-21. Additionally, Applicant argues that the top side of the base layer does not have a means for removable fastening. Examiner points to cut outs 28-29 which functions to accept respective structures on a mount placed on the base layer. This helps to releasably fasten the mount securely in place, see column 2, lines 58-59 and Fig. 1.

Conclusion

14. No claims allowed.

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 1743

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to P. Kathryn Bex whose telephone number is (703) 306-5697.

The fax number for the organization where this application or proceeding is assigned is (703) 305-7718 for official papers prior to mailing of a Final Office Action. For official papers after mailing of a Final Office Action, use fax number (703) 305-3599. For unofficial or draft papers use fax number (703) 305-7719. Please label all faxes as official or unofficial.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Kathryn Bex
P. Kathryn Bex
Patent Examiner
AU 1743
07/25/01

Arlen Soderquist
ARLEN SODERQUIST
PRIMARY EXAMINER